

IN THE CLAIMS:

Please replace claim 11 as follows:

11. (Amended) A laminate comprising the polyamide film of claim 8.

REMARKS

Claims 8-14 are pending herein. The Office Action dated January 12, 2001 rejected claims 8-14 under 35 U.S.C. §112, first paragraph; and rejected claim 11 under 35 U.S.C. §112, second paragraph. This Amendment amends the specification and claim 11. Entry of these same amendments in Applicants' previously filed April 12, 2001 and May 14, 2001, Amendment After Final Rejections was refused. No new matter is added.

Entry of this Amendment is proper under 37 C.F.R. §1.116 because the Amendment places the application in condition for allowance (for the reasons discussed herein) or places the application into better form for appeal should an appeal be necessary. The Amendment does not present any additional claims without canceling a corresponding number of finally rejected claims, does not raise the issue of new matter, and does not raise any new issues requiring additional search and/or consideration since the Amendment is directed to subject matter previously considered during prosecution. Furthermore, the amendments are necessary and were not earlier presented because they are in response to issues raised in the Final Rejection. The Amendment merely amends the specification to correct errors made during translation and amends claim 11 to correct a typographical error. Applicants respectfully request entry of the Amendment.

I. Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejected claims 8-14 under 35 U.S.C. §112, first paragraph, as containing subject matter not adequately disclosed in the original specification. The Office Action alleged that the phrase "each carbon atom immediately adjacent to a triple bonded

carbon atom is to be substituted with a hydroxyl group and a methyl group" defining the acetylene glycol of the claimed polyamide film defined in claim 8 at lines 5-6 was not adequately described in the specification. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the rejection is improper because the subject matter of claims 8-14 is adequately supported by the original specification. Enclosed is a verified statement of a translator showing that a translation error occurred in translating the section of the Japanese-language document WO 99/02341 corresponding to page 5, lines 22-24 of the present specification. WO 99/02341 is the international application upon which the national stage application is based, and thus represents the original application in the present prosecution. Thus, WO 99/02341 is not a foreign priority document under 35 U.S.C. §119. Applicants respectfully assert that they are entitled to rely on WO 99/02341 to provide support for the present amendment and as evidence that a translation error occurred.

Moreover, although MPEP §2163.07 may state, "where a non-English foreign priority document under 35 U.S.C. §119 is of record in the application file, Applicant may not rely on the disclosure of that document to support correction of an error in the pending application", MPEP §2163.07 further states, "this prohibition does not apply in a situation where the original application is in a non-English language (37 CFR 1.52(d))." The present application is a national stage application of an international application. Thus, the international application, i.e., the "the original application" under MPEP §2163.07, is in Japanese. Therefore, Applicants may rely on this original application for support in the correction of the translation error in the pending application.

Furthermore, it must be emphasized that even without the correction of the translation error, the present specification still fully supports the change. Specifically, Figure 1 (attached with the May 14, 2001 Amendment After Final Rejection) shows the chemical structures of several substituted acetylene glycols and their addition products (the Surfonyl products) used

in the present invention and described at page 5, lines 22-29. Thus, the specification discloses specific, proprietary compounds having the described chemical structure. Note that the carbon atoms immediately adjacent to the triple bonded carbon atoms in these commercial compounds are substituted with a methyl and a hydroxyl group.

In view of the verified translator's statement, the presence of specific examples supporting the description, and the arguments in Applicants' April 12, 2001 and May 14, 2001 Amendment After Final Rejection, it is clear that the cited portions are in fact adequately described in the specification in accordance with 35 U.S.C. §112, first paragraph.

For at least these reasons, claims 8-14 satisfy the requirements of 35 U.S.C. §112, first paragraph. Reconsideration and withdrawal of the rejection are respectfully requested.

II. Applicants' Use of Acetylene Glycol

Applicants do not understand the Office Action's assertion that acetylene glycol is used in the generic sense. Claim 8 is directed to a polyamide film comprising a component A which is an aqueous dispersion of polyurethane containing acetylene glycol that is substituted. Applicants respectfully direct the Patent Office's attention to Figure 1 submitted with the May 14 Amendment After Final Rejection which shows several examples of the substituted acetylene glycols of the present invention, i.e., Surfonyl 104, 440 and 82. From identification of these Surfonyl products, it is clear that acetylene glycol as used in the specification is in fact used in the generic sense.

III. Rejection Under 35 U.S.C. §112, Second Paragraph

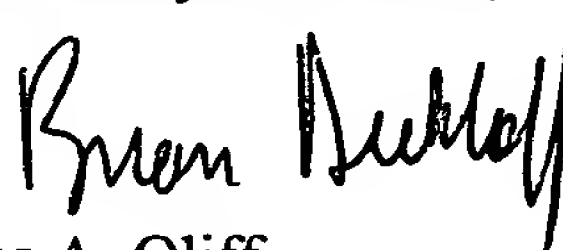
The Office Action rejects claim 11 under 35 U.S.C. §112, second paragraph, as being indefinite. This Amendment amends claim 11 to overcome this rejection. Claim 11 satisfies the requirements of 35 U.S.C. §112, second paragraph. Reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that the instant application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are respectfully solicited.

Should the Examiner believe that anything further is necessary in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number provided below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Brian B. Diekhoff
Registration No. 46,353

JAO:BBD/rxg

Date: June 12, 2001

Attachments:
Appendix
Verified Translation

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--